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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,019	10/20/2003	Jeremy Nathans	JHU1380-2	5064

7590 02/23/2007  
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EXAMINER
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DUFFY, PATRICIA ANN

ART UNIT	PAPER NUMBER
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1645

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	02/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.



### DETAILED ACTION

It is noted that the previous restriction requirement did not take into account the preliminary amendment filed. As such, a new restriction requirement is set forth below to clarify the record. The previous restriction requirement is vacated.

Claims 1-18 have been cancelled. Claims 19-40 are pending and under examination.

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 19, 20 and 38-40, drawn to antibodies that bind fibroblast growth factor homologous factor-4, classified in class 530, subclass 388.24.
- II. Claims 21-29, drawn to methods of detecting a cell proliferative disorder, classified in class 435, subclass 7.2.
- III. Claims 30-35, drawn to a method of treating a cell proliferative disorder using a reagent that suppresses the activity of the fibroblast growth factor homologous factor activity, classified in class 514, subclass 44.
- IV. Claims 36-37, drawn to a method of identifying a nucleic acid encoding a fibroblast homologous factor polypeptide, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions II, III and IV are directed to related methods. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have different designs, function and effects. The methods of invention II detect proliferative disorders, whereas the methods of invention III treat proliferative disorders and the methods of invention IV detect encoding nucleic acids.

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The methods and goals of the preambles and methods steps provide for inventions that have different functions and different final outcomes. The claims are not obvious variants and do not overlap in scope as one method could not be used to either anticipate or render the other method obvious.

Inventions I and IV are directed to an unrelated product and process. Product and process inventions are unrelated if it can be shown that the product cannot be used in, or made by, the process. See MPEP § 802.01 and § 806.06. In the instant case, the antibody that binds fibroblast growth factor homologous factor is not used in or made by the process of detection of nucleic acids encoding the fibroblast growth factor homologous factor. As such, the product and process are unrelated.

Inventions I and II or III are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the antibody can be used in a method of purification of the fibroblast growth factor homologous factor from nature.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

### *Species Election*

This application contains claims directed to the following patentably distinct species of the claimed invention:

#### *Group II:*

Species A: nucleic acid

Species B: antibody

#### *Group III:*

Species A: nucleic acid

Species B: antibody

Each species is distinct each from the other because they have different primary structures. The structures do not anticipate nor render any one of the others obvious. Further the search for an antibody would not reveal art on the nucleic acid.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, *Group II:*

21, 22, 27, 28 and 29; and *Group III:* 30, 33 and 34 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

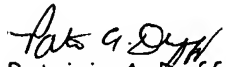
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A. Duffy whose telephone number is 571-272-0855. The examiner can generally be reached on M-Th 7:30 am - 6:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Mark Navarro can be reached on 571-272-0861.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

  
Patricia A. Duffy

Primary Examiner

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